

October 31, 2011

Cynthia C. Henderson, Esq.
Attorney Advisor
Office of Policy and External Affairs
U.S. Patent and Trademark Office
Mail Stop External Affairs
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Ms. Henderson:

The American Intellectual Property Law Association ("AIPLA") appreciates the opportunity to participate in the User Group Session during the 10th Annual Trademark Trilateral Cooperation Meeting in Alexandria, Virginia, December 5–7, 2011.

AIPLA is a national bar association with approximately 16,000 members who are primarily lawyers in private and corporate practice and government service and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law. Our members represent both owners and users of intellectual property.

The USPTO has requested that user groups provide comments concerning what practices and procedures we would like to see other IP offices harmonize and what areas might be improved in the respective IP offices participating in the Trilateral Cooperation Meeting.

We offer the following comments for consideration.

1. Consent Agreements

The USPTO accepts consent agreements which are used to overcome prior cited applications or registrations for the same or similar mark. A consent agreement, if submitted, will be considered by the Examining Attorney with all other evidence in the record to determine likelihood of confusion. The Examining Attorneys may not solicit consent agreements. In order for a consent agreement to be considered persuasive, it must generally include details as to why no likelihood of confusion exists and/or arrangements were undertaken by the owners to avoid confusing the public.

Currently, the Japanese and Korean Trademark Offices do not accept letters of consent. In order to address the situation relative to similar marks cited against applicants, trademark owners in Japan and Korea often temporarily assign their mark to an applicant until the applicant's mark matures to registration.

In the alternative, a pending application may be assigned to the owner of a cited mark, and once the applicant's mark matures to registration, it is assigned back to the original applicant. We suggest that Japan and Korea consider accepting letters of consent in lieu of the process that requires the parties to engage in a temporary two-step assignment process in order to avoid a likelihood of confusion refusal by the Japanese and Korean Trademark Offices.

It is our understanding that the Chinese Trademark Office may consider letters of consent provided that the marks are not identical. However, we also understand that the Chinese Trademark Office will likely deny registration even when a letter of consent is presented by a registrant and applicant. We suggest that China consider taking steps to reexamine policies relating to the acceptance of letters of consent.

2. Classification Issues

It is our understanding that the USPTO has been working with other Trademark Offices to address the differences between jurisdictions relative to the specificity required for identifications of goods and services, and it is believed that representatives from the USPTO, the European Trademark Office (OHIM) and the Japanese Patent Office (JPO) currently review identifications to determine those they agree will be acceptable within all three jurisdictions. This approach toward some conformity in descriptions of goods and services can be a great advantage for trademark owners wanting to protect their marks internationally. By using identifications that have been pre-approved for use in Europe, Japan, and the United States, trademark owners may have a greater degree of confidence that their identifications will be accepted in all three jurisdictions, which could result in a cost savings for trademark owners in the context of reducing prosecution costs.

We understand that OHIM encourages applicants to register their marks for goods and services that correspond with class headings, and that several European countries do not treat the class headings as supporting trademark rights relating to protection for all the goods in the particular class. These overly broad registrations do not accurately reflect the real interest of the trademark owner in covering the goods of actual interest, making it difficult for parties to clear new trademarks. It is also believed that overly broad identifications are counterproductive because third parties may be more likely to oppose an application which broadly states goods or services. We suggest that OHIM consider requiring trademark applicants to use more specificity when identifying the goods and services in trademark applications.

It is our understanding that Korea and China have adopted the Nice Classification System. However, they have further adopted subclassifications—which becomes problematic when trademark owners encounter refusals to register their marks when unrelated goods are grouped together in the same subclass. This general approach to examination leads to refusals to register marks when the likelihood of confusion is *de minimus* in reality because the parties' goods or services in the application or registration are different, or their channels of trade are different, or their targeted consumers can be distinguished. We suggest that China and Korea consider adopting the Nice Classification System entirely without subclassification.

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3. Responsive Deadlines

When an Office Action issues from the USPTO, applicants are afforded six months to respond. OHIM affords applicants two months to respond to Office Actions and further affords the possibility of requesting an extension of time to file a response.

The Chinese Trademark Office affords the applicant two weeks to file a response to an Office Action. We believe that this short deadline provides insufficient time to prepare a response. It further negatively impacts foreign applicants who are likely corresponding with the Chinese Trademark Office through local Chinese counsel, which means that, in many instances, additional time is required to review the Office Action between Chinese and foreign counsel and their clients. We recommend that China consider a longer period of time for responding to official Office Actions and consider extending the deadline for responding to three months from the date the Office Action is mailed to the applicant or its representative in China.

AIPLA appreciates the opportunity to provide comments for the Trademark Trilateral Cooperation Meeting.

Sincerely,

A handwritten signature in black ink, appearing to read "William G. Barber", with a long horizontal flourish extending to the right.

William G. Barber
AIPLA President